

Appl. No.: 09/608,311
Amdt. Dated: 12/18/2003
Off. Act. Dated: 06/18/2003

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the discussion presented herein.

1. Priority Date of Application.

Based on the rejections in this Office Action, it appears that the priority claim may have been overlooked by the Examiner and/or potential confusion regarding the priority claim was introduced as a result of the substitute specification that was filed on February 21, 2003. In this regard, please note that the substitute specification was a substitute for the original (as noted therein) and, therefore, only set forth the priority claims (and other material) contained in the original filing. Otherwise, subsequent amendments would not be properly matched with the specification.

Applicant's First Preliminary Amendment, filed on March 2, 2001, amends the specification to read as follows:

"This application claims the benefit of prior provisional application serial number 60/141,698, filed on June 30, 1999 and provisional application serial number 60/059,471, filed on September 22, 1997. This application is a continuation in-part of application serial number 09/158,037 filed on September 22, 1998, now U.S. Patent No. 6,173,604, which is a continuation-in-part of application serial number 08/717,321 filed on September 20, 1996, now U.S. Patent No. 5,821,410."

Each of the priority documents have at least one common inventor (e.g., Xiao-Dong Xiang) and have common ownership. Ownership information by The Regents of the University of California can be verified as follows:

- (a) U.S. Ser. No. 08/717,321 filed on September 20, 1996, now U.S. Patent No. 5,821,410. The assignee shown in the face of the issued patent is The Regents of the University of California.

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- (b) U.S. Ser. No. 09/158,037 filed on September 22, 1998, now U.S. Patent No. 6,173,604. The assignee shown in the face of the issued patent is The Regents of the University of California.
- (c) U.S. Ser. No. 09/608,311 filed on June 30, 2000 (the instant application). An assignment in favor of The Regents of the University of California was recorded on December 4, 2000 at Reel/Frame 011326/0850.

As can be seen, therefore, the effective filing date of the instant application is September 20, 1996 (Xiang et al., 5,821,410). This application is entitled to the priority date of Xiang et al. for all claims that are supported by the disclosure of Xiang et al..

2. Rejection of Claim 22 under 35 U.S.C. § 102(b) Based on Wei et al.

Claim 22 was rejected under 35 U.S.C. § 102(b) as being anticipated by Wei et al. "Scanning Tip Microwave Near-field Microscope" by Wei et al. published on June 10, 1996.

In response, the Applicant respectfully calls to the attention of the Examiner that this application is a continuation-in-part of serial number 09/158,037 filed on September 22, 1998 (now U.S. No. 6,173,604) which is a continuation-in-part of serial number 08/717,321 filed on September 20, 1996 (now U.S. No. 5,821,410). Therefore, the effective priority date of the instant application is September 20, 1996. Furthermore, the subject matter of Claim 22 is fully supported by U.S. Patent No. 5,821,410.

Therefore, the rejection under §102(b) is improper since the cited reference did not publish more than one-year prior to the effective filing date of this application.

And, with regard to a potential rejection under §102(a), the Applicant further calls to the attention of the Examiner that the Wei et al. reference was authored by four individuals who were under an obligation to assign their rights to the assignee of the instant application at the time the instant invention was made. In other words, the Wei et al. reference is was not by an entity other than the inventors or assignee. See, MPEP 706.02(c). Therefore, even a rejection under §102(a) would be improper.

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The assignee herein is The Regents of the University of California. The four authors of the cited reference, Tao Wei (T. Wei), Xiao-Dong Xiang (X. D. Xiang), W.G. Wallace Freedman, and P.G. Schultz, were under an obligation to assign their rights, if any, in the subject matter of the cited reference to the assignee hereof at the time the invention was made. In this regard, note that two of the four authors are identified as being directly associated with the University of California, while the other two are identified as being associates with the Lawrence Berkeley National Laboratories which is a part of the University of California. For the University of California patent policy, see <http://www.ucop.edu/ott/patentpolicy/patentpo.html>. Also see, MPEP § 706.02(I)(2)(II) for establishing common ownership.

Therefore, the invention of Claim 22 and the cited reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity; namely, The Regents of the University of California.

Accordingly, since the cited reference was published less than one year prior to the effective filing date of the instant application, the rejection under §102(b) should be withdrawn. Furthermore, since the subject matter claimed in the instant application and the subject matter of the Wei et al. reference were commonly owned at the time later invention was made, a rejection under §102(a) would be improper as well. See, MPEP §706.02(I). Therefore, Wei et al. does not anticipate Claim 22.

Furthermore, in order for a rejection under §102(a) to be proper, the reference must not be the applicant's own work. See, MPEP §706.02(a). In the instant case, the cited reference is a jointly authored paper wherein Xiao-Dong Xiang, an inventor herein, is listed as a co-author. Enclosed herewith is a declaration under Rule 132 wherein Xiao-Dong Xiang states that he was the sole inventor of the subject matter of Claim 22 and that the other co-authors were working under this direction. See, MPEP §715.01(c); In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

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2. Rejection of Claim 22 under 35 U.S.C. 102(b) based on Yalin et al.

Claim 22 was also rejected as being anticipated by Yalin et al. (actually should be Lu et al.) "Nondestructive Imaging of Dielectric-Constant Profiles and Ferroelectric Domains with a Scanning-Tip Microwave Near-Field Microscope" published June 27, 1997.

As explained above, the effective priority date of the instant application is September 20, 1996, and Claim 22 is fully supported by the priority document. Therefore, Yalin et al. was published after the effective filing date of the instant application and is not prior art as against Claim 22. Accordingly, the rejection under 35 U.S.C. §102(b) should be withdrawn.

3. Rejection of Claims 22-53 under 35 U.S.C. §102(e).

Claims 22-53 were rejected as being anticipated by Xiang et. al. (US Patent No. 5,821,410). Claims 22 and 53 are independent.

As explained above, the instant application is a continuation-in-part of the cited reference and is entitled to the priority date thereof. Furthermore, Claims 22 and 53 are fully supported the cited reference, and Xiao-Dong Xiang is the sole inventor of the subject matter of those claims (see Rule 132 Declaration enclosed herewith). Therefore, Xiang et al. is not prior art under 35 U.S.C. §102(e) since this application claims priority to Xiang et al. This application is entitled to the priority date of Xiang et al. for all of the subject matter of Xiang et al. that is being used as the basis of a rejection under 35 U.S.C. §102(e).

Accordingly, the rejection under 35 U.S.C. §102(e) should be withdrawn.

4. Conclusion.

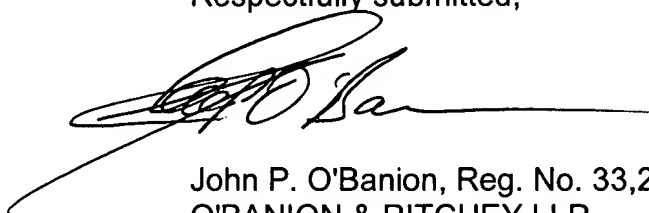
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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The Applicant also respectfully requests a telephone interview with the Examiner in the event that there are questions regarding this response, or if the next action on the merits is not an allowance of all pending claims.

Date: 12/11/2003

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John P. O'Banion", written over a horizontal line.

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